

## REMARKS

Claims 1-5, 9-10, 13-15, and 17-18 are pending in the application. Claims 1 and 9 are amended herein.

### Title of the Invention

In the response to the office action dated 08/25/2008, the title of the invention had been amended as shown on the title page of the present amendment. However, the EFS and file wrapper continue to show the old title. Appropriate correction is respectfully requested.

### Improper Finality

On page 10 of the office action, the Examiner stated that “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL.”

For the following reasons, the Applicant submits that the finality of the last office action (dated 01/05/2010) is improper and should be withdrawn.

First, the Applicant notes that, in the office action dated 06/16/2009, the Examiner rejected then pending claims 8 and 16 under 35 U.S.C. § 102(b) as being anticipated by Hoke.

In Applicant’s response dated 09/24/2009, independent claims 1 and 9 were amended to include the limitations of claims 8 and 16, respectively. Claims 8 and 16 were canceled. After the amendment, claim 1 became equivalent to previously pending claim 8 rewritten in independent form, and claim 9 became equivalent to previously pending claim 16 rewritten in independent form.

In the last office action (dated 01/05/2010), independent claims 1 and 9 (equivalent to previously pending claims 8 and 16, respectively) are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoke in view of Taylor. Therefore, the Examiner introduced a new ground of rejection for pending claims 8 and 16, now presented as claims 1 and 9, respectively. Presumably, the Examiner did not and/or could not maintain the initial grounds of rejection for the two claims in question because Applicant’s arguments with respect to the allowability of those claims over Hoke alone clearly established that the initial rejection was improper. It is therefore follows that the **improperness of the rejection over Hoke alone**, and not Applicant’s amendment, **necessitated the new grounds of rejection**.

Since MPEP § 706.07(a) **explicitly prohibits** making the rejection final “where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c),” it is submitted that the finality of the office action dated 01/05/2010 is improper and should be withdrawn.

### Improper Rejection of Claims 17 and 18

The grounds of rejection for claims 17 and 18 are not explicitly stated in the office action and, as such, are unclear. From the text of the rejection, it appears that the Examiner rejects claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Hoke in view of Sakurai.

Claim 17 is a dependent claim that depends from claim 9. Claim 18 is a dependent claim that depends from claim 1. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) based on the combination of Hoke and Taylor.

It is improper to reject a dependent claim over a combination of references that does not include all of the references used to reject a claim from which that dependent claim depends because

the omission makes such a rejection substantively incomplete. Since the present rejection of dependent claims 17 and 18 fails to include Taylor in the combination of references, this rejection is improper and should be withdrawn.

#### Claims 1-5, 9-10, and 13-15

On page 2, the Examiner rejects claims 1-3, 5, 9-10, 13, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Hoke in view of Taylor. On page 7, the Examiner rejects claims 4 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Hoke in view of Taylor and Holmes.

Support for the amendment of claim 1 can be found in Applicant's specification, e.g., on page 4, lines 15-24. Claim 9 is amended similar to claim 1.

Amended claim 1 is directed to a mobile phone set having a personal locator beacon transmitter circuit, a microprocessor, and a short range transceiver that are operatively coupled to one another. The personal locator beacon transmitter circuit transmits a beacon that includes (i) an identification code selected from a serial number and a phone number of the mobile phone set and (ii) emergency information received through the short range transceiver from a device external to the mobile phone set. The microprocessor activates the beacon transmission only when there is no mobile phone service available and the user of the mobile phone set requests emergency service.

Hoke discloses a cellular phone capable of transmitting emergency information using a carrier wave at 406 MHz. On page 4 of the office action, in the rejection of claim 1, the Examiner admits that Hoke does "not disclose receiving emergency information from a short range transceiver located in the mobile phone handset." To remedy this admitted deficiency of Hoke with respect to claim 1, the Examiner cites and relies on Taylor.

Taylor discloses a monitoring system that has a monitoring device attached to a person with the purpose of positional tracking of the person and monitoring a bodily function of the person. To monitor a bodily function, the monitoring device has medical-monitoring means, e.g., for measuring blood pressure, heart-beat rate, respiration rate, bodily temperature, blood oxygen level, and/or blood alcohol level (see, e.g., Taylor's col. 12, lines 15-25). The monitoring device further has a short-range transmission antenna for transmitting the bodily function data to a secondary transportable device (see, e.g., Taylor's col. 10, lines 22-32).

First of all, the Applicant submits that the combination of Hoke and Taylor is improper, e.g., because Taylor has nothing to do with cellular telephony.

Second, even if the combination of Hoke and Taylor were proper, which the Applicant does not admit, then this combination would still be substantively insufficient to support the rejection of claim 1. More specifically, it appears that the Examiner alleges that, if Hoke's cellular phone is modified to include the above-described capabilities of Taylor's monitoring device, then the resulting modified cellular phone can serve as an example of the mobile phone set defined by claim 1. However, the modified cellular phone would (1) receive medical information from the medical-monitoring means, which is an **internal** part of the modified cellular phone, and (2) then use the short-range transmission antenna to relay the medical information to the secondary transportable device. Clearly, this mode of operation is different from that defined by claim 1 for at least two reasons. The first reason is that the modified cellular phone generates medical information using an internal component (i.e., the medical-monitoring means) while claim 1 requires that emergency information be received from a device **external** to the mobile phone set. The second reason is that the modified cellular phone uses the short-range transmission antenna to **transmit** the medical information while claim 1 requires that the emergency information be **received** (not transmitted) through the short range transceiver.

For at least these reasons, the Applicant submits that amended claim 1 is allowable over the cited references. For similar reasons, the Applicant submits that amended claim 9 is also allowable over the cited references. Since claims 2-5, 10, 13-15, and 17-18 depend variously from claims 1 and 9, it is further submitted that those claims are also allowable over the cited references.

In view of the above amendments and remarks, the Applicant believes that all pending claims are in condition for allowance. Therefore, the Applicant believes that the entire application is now in condition for allowance, and early and favorable action is respectfully solicited.

#### Fees

During the pendency of this application, the Commissioner for Patents is hereby authorized to charge payment of any filing fees for presentation of extra claims under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17 or credit any overpayment to **Mendelsohn, Drucker, & Associates, P.C. Deposit Account No. 50-0782**.

The Commissioner for Patents is hereby authorized to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR § 1.136 for its timely submission, as incorporating a petition for extension of time for the appropriate length of time if not submitted with the reply.

Respectfully submitted,

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